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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,716	12/04/2001	Ronald Alfred Greinke	N-7980	2324

7590 09/04/2003

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Wilmington, DE 19803

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EXAMINER

WONG, EDNA

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,716

Applicant(s)

GREINKE, RONALD ALFRED

Examiner

Edna Wong

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) 34-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 21-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 5. 6) ☐ Other:

Election/Restrictions

Applicant's election of Group I, claims **21-33** in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Accordingly, claims **34-40** are withdrawn from consideration as being directed to a non-elected invention.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

Claim **32** is objected to because of the following informalities:

Claim 32

line 12, it is suggested that the word -- solution -- be inserted after the word "intercalant".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims **22, 23, 31 and 32-33** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22

line 3, it appears that the "electrolytic oxidation" is the same as that recited in claim 21, line 4. However, it is unclear if it is. If it is, then it is suggested that the word -- said -- be inserted after the word "to".

Claim 23

line 4, it appears that the "electrolytic oxidation" is the same as that recited in claim 21, line 4. However, it is unclear if it is. If it is, then it is suggested that the word -- said -- be inserted after the word "to".

Claim 31

lines 2-3, "the intercalant wet graphite flake" lacks antecedent basis.

Claim 32

lines 8-9, it appears that "an electrolytic oxidation" is the same as the electrolytic treatment recited in claim 32, lines 6-7. However, it is unclear if it is. If it isn't, then what is the difference between the electrolytic oxidation and the electrolytic treatment?

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **21-33** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **1-21** of U.S. Patent No. 6,406,612 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 21-33 of the present invention fail to be patentably distinct from the inventions claimed in claims 1-21 of the patent because the claim limitations of (a) contacting graphite flake with an organic expansion aid and (b) subjecting said graphite flake to an electrolytic oxidation treatment with an aqueous intercalant solution comprising sulfuric acid are common to all the claims. It appears that Applicants have taken these claim limitations from the patent and changed these claim limitations around by incorporating (narrowing) or removing (broadening) independent and dependent claim limitations from the patent into making the present set of claims. Thus, the claims are not patentably distinct from each other because the claims of the present invention fail to be patentably distinct from the inventions claimed in the claims of the above patent because the independent claims of the present invention recite claim limitations that are readable on, either alone or in combination with their dependent claims, the claims of the patent and vice versa, wherein the claims of the

patent are encompassed by the claims of the present invention. Therefore, the claims would have been an obvious variant over each other.

Note that 10-75% sulfuric acid is claimed in the patent.

Citations

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Greinke et al. (US Patent No. 6,416,815) is cited to teach a method for providing intercalated graphite flake with increased exfoliation volume at exfoliation temperatures of 600°C or lower comprising the steps of adding carboxylic acid organic expansion aid to an oxidizing intercalant solution and heating.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (703) 308-3818. The examiner can normally be reached on Mon-Fri 7:30 am to 5:00 pm, alt. Fridays off.

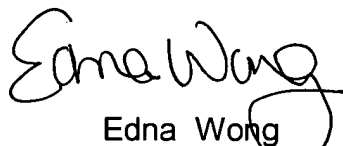
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (703) 308-3322. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-

Application/Control Number: 10/004,716
Art Unit: 1753

Page 6

1495.


Edna Wong
Primary Examiner
Art Unit 1753

EW
August 31, 2003